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for Records
of Appeal
Brief

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

MUMTAZ SHAH

SERIAL NO.: 09/403,796

ART UNIT: 3724

FILED: OCTOBER 25, 1999

EXAMINER: CHARLES GOODMAN

TITLE: CUTTING SHEET MATERIAL

8/14/03
J. M. H. Ant

REQUEST FOR REINSTATEMENT OF APPEAL
AND SUPPLEMENTAL APPEAL BRIEF
TECHNOLOGY CENTER R3700

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Request for Reinstatement of Appeal

In reply to the Office Action, dated May 7, 2003, issuing a new ground for rejection and re-opening prosecution on the merits, Applicant, Appellant herein, hereby requests reinstatement of the previously-pending appeal, which was taken from the final rejection of Claims 20-24.

What follows is, therefore, Appellant's Supplemental Appeal Brief, pursuant to 37 C.F.R. §1.192(c) and M.P.E.P. §1208.02, filed in triplicate. The Supplemental Appeal Brief incorporates by reference such parts of Appellant's Amended Appeal Brief, filed February 19, 2003, as may still be appropriate and applicable. The requisite fee for filing the

I hereby certify that this paper is being deposited this date with the U.S. Postal Service as First Class Mail addressed to: Hon. Commissioner for Patents, United States Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450.

Edwin D. Schindler
Edwin D. Schindler, Reg. No. 31,459

August 6, 2003
Date

Appeal Brief, as set forth in 37 C.F.R. §1.17(f), was previously paid on October 31, 2002. No additional fee is due for this Supplemental Appeal Brief.

I. Real Party in Interest

(37 C.F.R. §1.92(c)(1))

The real-party-in-interest is the inventor, Mumtaz Shah. The instant patent application has not been assigned.

II. Related Appeals and Interferences

(37 C.F.R. §1.92(c)(2))

There are no related appeals or interferences pending.

III. Status of Claims

(37 C.F.R. §1.92(c)(3))

The status of the claims is unchanged from that as indicated in the Amended Appeal Brief (at pp. 2 - 6), filed February 19, 2003, and consequently Appellant incorporates by reference Section III of the Amended Appeal Brief, as appropriate. See, M.P.E.P. §1208.02.

In the Office Action, dated May 7, 2003, the Examiner has withdrawn the prior art rejections previously of record, and has issued new grounds for rejection based upon the prior art of Marcoux, U.S. Patent No. 3,835,536, in combination with other art previously applied. Because Appellant submits that Claims 20-24 remain patentable, notwithstanding the new-

ly-issued grounds for rejection, no new claim amendments have been entered in response to the Office Action, dated May 7, 2003.

Therefore, the status of the claims on appeal is:

Claims allowed: None

Claims objected to: None

Claims rejected: Claims 20-24

Claims cancelled: Claims 1-19

IV. Status of Amendments

(37 C.F.R. §1.192(c)(4))

No amendments after final Action were filed, nor were any amendments filed in reply to the non-final Office Action, dated May 7, 2003. The status of the claims is unchanged from that indicated in the final Office Action, dated March 26, 2002, and unchanged from that stated in the Amended Appeal Brief, filed February 19, 2003. A complete copy of the claims on appeal, as required pursuant to 37 C.F.R. §1.192(c)(9), accompanies this Appeal Brief.

V. Summary of Invention

(37 C.F.R. §1.192(c)(5))

Appellant's invention provides an apparatus for cutting sheet material, which can be used to cut along other than a straight line, and which, preferably, may be used freely

(i.e., is "freely movable" without restriction in both linear and non-linear directions) over the entire area of the sheet of material. (See, Specification at Page 1, lines 18-21) Prior to the present invention, conventional cutting apparatus could only be utilized for cutting sheets to pre-determined sizes and in a straight line. (See, Specification at Page 1, lines 12-17) For cutting sheet material, whether it be paper or cloth, etc., in other than a straight line, the craftsman would be required to use scissors or shears for a free-hand, non-linear cutting procedure.

The foregoing and related objects are achieved by the apparatus of the present invention for cutting sheet material (10), which includes a unit (11, 12) freely movable in both linear and non-linear paths (see, Specification at Page 3, lines 14-19), which has a lower part (11) defining a sheet support surface for placement of a piece of sheet material, and an upper part (12) defining an upper surface and disposed above said lower part with a gap (13) existing between said upper part (12) and said lower part (11) for receiving the piece of sheet material (23). (See, Specification at Page 4, lines 12-17) A cutting blade (14) is secured in the upper (12) and lower parts (11), and extends across said gap (13). (See, Specification at Page 5, lines 5-13) The sheet support surface (16) and the upper surface (12) extend to either side of the cutting blade (14). (See, Specification at Page 5, lines 5-13) Pressure means (e.g.,

wheel (22) is mounted on the upper part in the gap for bearing on the piece of sheet material (23) supported by the lower part (11) adjacent to the cutting blade (14) (see, Specification at Page 5, line 19 - Page 6, line 1), so that the piece of sheet material (23) is able to be inserted between the pressure means (23) and the sheet support surface (16) for tensioning the piece of sheet material (23) in the vicinity of the cutting blade (14). (See, Specification at Page 5, lines 5-10)

As will be explained in greater detail hereinafter, nowhere in the prior art is such a novel and efficient apparatus for cutting sheet material in both linear and non-linear paths either disclosed or suggested.

VI. Issues

(37 C.F.R. §1.192(c)(6))

The issues presented in this (Reinstated) Appeal are as follows:

A. Claims 20-22 have been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Marcoux, U.S. Patent No. 3,835,536, taken in view of Campbell, Jr., U.S. Patent No. 3,068,569;

B. Claim 23 has been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Marcoux, taken in view of Campbell, Jr., as applied to Claims 20-22, and in further

view of Shah, United Kingdom Patent Application No. 2,223,976; and,

C. Claim 24 has been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Marcoux, taken in view of Campbell, Jr., as applied to Claims 20-22, and in further taken in view of Li, U.S. Patent No. 5,638,603.

Claims 1-19 have been cancelled.

The prior art grounds for rejection recited in Section VI of the Amended Appeal Brief, filed February 19, 2003, have all been withdrawn.

VII. Grouping of Claims

(37 C.F.R. §1.192(c)(7))

Claim 20 is the single independent claim pending in the above-identified patent application. The following obviousness rejection will be argued separately in this Supplemental Appeal Brief:

Claims 20-22 have been rejected as being obvious, pursuant to 35 U.S.C. §103(a), over Marcoux, U.S. Patent No. 3,835,536, taken in view of Campbell, Jr., U.S. Patent No. 3,068,569.

The obviousness rejections issued against dependent Claims 23 and 24, which are separate from the prior art rejections issued against independent Claim 20, will not

be separately argued, and the patentability of these dependent claims will be allowed to stand or fall on the basis of whether independent Claim 20 is patentable.

VIII. Argument

(37 C.F.R. §1.192(c)(8))

A. The Legal Scope of Appellant's Independent Claim 20

Having withdrawn the prior art rejections previously of record, as recited in the final Office Action, dated March 26, 2002, it would appear that the Examiner and Appellant are in agreement as to the legal scope of Appellant's independent Claim 20 and, more particularly, the patentable weight to be accorded to the terminology "freely movable" recited in this claim. To the extent that the intended scope of the subject matter recited in Claim 20 remains a contested issue on this appeal, Appellant hereby incorporates by reference the argument contained at Pages 10 - 15 of the Amended Appeal Brief, filed February 19, 2003. See, M.P.E.P. §1208.02.

B. The 35 U.S.C. §103(a) Obviousness Rejection of Claims 20-22 over Marcoux, Taken In View of Campbell, Jr.

In the Office Action, dated May 7th, 2003, the Examiner withdrew all prior grounds for rejection and issued a new prior art rejection against independent Claim 20 (and dependent Claims 21 and 22) as being obvious, pursuant to 35 U.S.C. §103(a), over Marcoux, U.S. Patent No. 3,835,536, taken in

view of Campbell, Jr., U.S. Patent No. U.S. Patent No. 3,068,569. It is the Examiner's contention that the primary reference of Marcoux (in the embodiments illustrated in FIGS. 8 - 11) discloses Appellant's invention substantially as claimed, including a freely movable unit in FIG. 8, an upper part (21), a lower part (27) and a cutting blade (22). The Examiner acknowledges that Marcoux lacks the pressure means of that recited in Appellant's claims, and has therefore secondarily-applied Campbell, Jr. for its contended disclosure of such pressure means, thereby allowing the Examiner to conclude that the combination of Marcoux, taken in view of Campbell, Jr., discloses that which is claimed by Appellant.

In reply to the Examiner's newly-issued obviousness rejection applying Marcoux, taken in view of Campbell, Jr., Appellant cannot agree with the Examiner that Marcoux teaches or suggests "a unit freely movable in both linear and non-linear paths" The Examiner has cited to the "second" embodiment of Marcoux in the obviousness rejection, which is FIGS. 8 - 11 of the applied reference and which is discussed at Col. 3, line 36 - Col. 4, line 6, of Marcoux. The sheet material cutter of Marcoux shown in FIGS. 8 - 11 is described as having a top portion (21), which

"includes a pair of substantially parallel opposite sides 23 and 24 forming each a straight edge adapted to run along a ruler 20, of any usual type."

See, Marcoux, Col. 3, lines 39 - 42.

The textual disclosure of Marcoux further states that:

"It can easily be seen that the cutter according to the second embodiment illustrated in FIGS. 8 to 11 inclusive may be displaced in either of two longitudinal directions to cut a sheet of paper S while being run against the lateral edge of a ruler 20, as shown in FIG. 11."

See, Marcoux, Col. 3, lines 39 - 42 (emphasis added).

The textual Specification of Marcoux makes quite clear that the "sheet material cutter" disclosed therein is to linearly cut a piece of paper, or other sheet material, and that curved, or non-linear cuts are not intended and would not appear to be possible with the cutter taught by Marcoux.

Aside from the teaching in Marcoux that a straight edge, such as that of a conventional ruler, should be used to guide movement of the sheet material cutter therein, even if the ruler or other straight edge was dispensed with - and there is no such teaching or suggestion apparent in Marcoux that this should, or could, be done - it is respectfully submitted that the "pair of substantially parallel opposite sides 23 and 24 forming each a straight edge" (see, Marcoux, Col. 3, lines 39 - 42) would compel a linear movement of the sheet material cutter of Marcoux, even if not guided by a ruler or other straight edge, as may be most clearly seen in FIG. 11. Specifically, the opposite sides (23, 24) of the sheet material cutter in FIG. 11 are shown extending downwardly to the lateral sharp edges (31'); since the opposite sides (23, 24) are described and shown as each forming a "straight edge" (see, Marcoux, Col. 3, line 41), there is a "continuous sharp

[straight] edge at the entire periphery of bottom portion 27." (See, Marcoux, Col. 3, lines 64 - 65.) The sheet cutter in Marcoux, it is therefore respectfully submitted, is guided to move linearly by its bottom construction, regardless of whether or not it is aligned against a straight edge, such as that of a ruler. The Marcoux sheet cutter would be unable to cut sheet material in a curved, or non-linear path, as can Appellant's claimed invention, as most broadly recited in pending independent Claim 20.

The secondary reference of Campbell, Jr. discloses a letter opener, which invariably cuts open letters, not sheets of paper in a straight, or linear, manner because: (a) the letter itself is invariably linear in form and (b) the groove through which the edge of the envelope to be cut open passes through forces a straight, or linear, cut. (Campbell, Jr., FIG. 2, reference numerals "5" and "6")

The present invention, as claimed, expressly recites the unit is "freely movable" in both linear and non-linear paths," which is clearly impossible for an envelope to so move through the opener in Campbell, Jr.¹.

Because Marcoux and Campbell, Jr. both disclose articles intended for cutting only in a linear path, and neither

1. Appellant hereby incorporates by reference from the Amended Appeal Brief (at pp. 21-24), filed February 19, 2003, the contention that Campbell, Jr. represents non-analogous art, to the extent that such argument remains relevant and applicable to the newly-issued obviousness rejection.

reference considered separately or in combination with one another suggests any manner of a non-linear cutting path (and, in fact, the construction of each would rule out a non-linear cutting path), Appellant respectfully submits that the presently claimed invention cannot reasonably be viewed as being obvious over the proposed combination of art.

In view of the limitation in Claims 20-24 that the unit of the present invention is "freely movable" and, therefore, capable of cutting in "both linear and non-linear paths," which is submitted to be clearly precluded by the devices of the applied prior art references, Appellant respectfully submits that the Board should reverse the issued 35 U.S.C. §103(a) obviousness rejection, which applies Marcoux, taken in view of Campbell, Jr.

IX. Summary

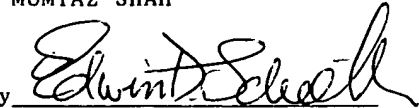
In summation, it is respectfully contended that all claims now pending in the above-identified patent application (i.e., Claims 20-24) recite a novel and efficient apparatus for cutting sheet material, which is freely movable in both linear and non-linear paths, which is patentably distinguishable over the prior art.

Accordingly, reversal of the Examiner's final rejection, pursuant to 35 U.S.C. §§102(b) and 103(a), and the allowance of all claims now pending are respectfully requested and earnestly solicited.

Respectfully submitted,

MUMTAZ SHAH

By



Edwin D. Schindler
Attorney for Appellant
Reg. No. 31,459

Five Hirsch Avenue
P. O. Box 966
Coram, New York 11727-0966

(631)474-5373

August 6, 2003

Enc.: Appendix - Claims on Appeal.

The Commissioner is hereby authorized to charge the Deposit Account of Appellant's Attorney, Account No. 19-0450, for any additional fees which may be due in connection with the prosecution of the present application, but which have not otherwise been provided for.



APPENDIX: CLAIMS ON APPEAL

(37 C.F.R. §1.192(c)(9))

[Claims 1-19 - Cancelled]

20. Apparatus for cutting sheet material, comprising:
a unit freely movable in both linear and non-linear paths having a lower part defining a sheet support surface for placing a piece of sheet material;

an upper part defining an upper surface and disposed above said lower part with a gap existing between said upper part and said lower part for receiving the piece of sheet material;

a cutting blade secured in said upper and lower parts, and extending across said gap, said sheet support surface and said upper surface extending to either side of said cutting blade; and,

pressure means mounted on said upper part in said gap for bearing on the piece of sheet material supported by said lower part adjacent to said cutting blade, so that the piece of sheet material is able to be inserted between said pressure means and said sheet support surface for tensioning the piece of sheet material in proximity of said cutting blade.

21. The apparatus for cutting sheet material according to Claim 20, further comprising a holder for said cutting blade between said upper part and said lower part.

22. The apparatus for cutting sheet material according to Claim 20, wherein said pressure means comprises a freely rotatable wheel, positioned immediately in front of said cutting blade.

23. The apparatus for cutting sheet material according to Claim 20, wherein an upper face of said lower part and a lower face of said upper part are shaped for providing matching sinusoidal surfaces for supporting said upper part and for tensioning said sheet material.

24. The apparatus for cutting sheet material according to Claim 20, further comprising a window provided in said upper part for viewing said sheet material when said sheet material is immediately in front of said cutting blade.